

**REMARKS****Amendments to the Claims**

Claims 3, 6, 9-11, 13, 24, 25 and 30 have been amended to correct typographical errors and/or informalities.

**Reply to Restriction Requirement**

Responsive to the Restriction Requirement dated August 25, 2003, the claims of Group I (Claims 1, 3, 4, 9 and 11-13), defined by the Examiner as being drawn to "a polypeptide having the ability to bind CEA comprising SEQ ID NO:110 wherein each of the eight X's in SEQ ID NO:110 is defined by amino acids ranging from groups of three to fifteen," are elected for further prosecution with traverse. Applicants further elect SEQ ID NO:59 (i.e., 304A-12-H12; DWVCEYFKNQWFCNVL) as the specific sequence to be examined. Applicants reserve the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicants do not hereby abandon or waive any rights in the non-elected inventions.

**Reasons for Traverse and Proposed Modification of the Restriction Requirement**

The requirement is being traversed for the reasons set forth in detail below. The Examiner has restricted the invention into 528,356,537,620 groups based upon the number of polypeptides that are encompassed by the claims. In this manner, the Examiner has restricted the members of a Markush group, which is improper unless it is shown that the subject matter lacks common utility and a common structural feature responsible for the utility.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility. (M.P.E.P. § 803.02 at 800-4 (8<sup>th</sup> ed., Latest Rev., Feb. 2003)).

Claims 1-13 of the subject application claim a polypeptide comprising a specified amino acid sequence. The specification teaches that the claimed polypeptides have a common structure of a short variegated peptide loop (Specification, page 12, line 11 *et seq.*). The claimed polypeptides further share a common utility, namely an ability to bind CEA.

When these two criteria are satisfied, M.P.E.P. § 803.02 provides a procedure for examining the entire scope of the claim containing the Markush Group. Specifically, there may be a requirement for an election of species, followed by an examination of the entire scope of the elected species and further to the extent necessary to determine patentability of the Markush-type claim.

In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. (M.P.E.P. § 803.02 at 800-5 (8<sup>th</sup> ed., Latest Rev., Feb. 2003); emphasis added)

Applicants therefore respectfully request that the restriction requirement be withdrawn and replaced with a requirement for an election of species. Applicants further request that the elected species be examined, and, upon a finding that the elected species is allowable over the prior art, that the entire scope of the claims be examined. In the event that the Restriction Requirement is replaced with a requirement for an election of species, Applicants hereby elect a polypeptide comprising the amino acid sequence depicted in SEQ ID NO:59 (i.e., 304A-12-H12; DWVCEYFKNQWFCNVL). Claims readable thereon are Claims 1, 2 and 8-13.

#### Telephonic Response of Examiner Canella

Applicants thank Examiner Canella for responding to Applicants' telephone call on October 10, 2003 and for agreeing to examine the subject application. It is Applicants' understanding that Examiner Canella will withdraw the pending Restriction Requirement and issue a new Restriction Requirement in accordance with the MPEP guidance cited above.

**CONCLUSION**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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